

REMARKS

I. Status of the Claims

Claims 3-5, 7, 8, 10-17, 19, 20, 22, 23, 25, 28-30 and 33-41 are pending in the application. Claims 7, 16, 20, 36, and 37-41 are independent claims. Claims 1, 2, 6, 9, 18, 21, 24, 26, 27, 31 and 32 have been cancelled. Product claims 3-5, and 35 have been rewritten as product-by-process claims (and each of these claims sets forth a product having an ink-jetted image with a resolution greater than 150 dpi). Claims 8, 10-15, 17 and 19 have been amended to depend from allowable Claim 7. Claim 21, which the Office Action indicated would be allowable if rewritten in independent form, has been cancelled and rewritten as independent Claim 20. Claim 22 has been amended to depend from claim 20. Claims 33 and 37 have been amended to delete the word "about." No new matter has been added.

II. Allowable Subject Matter

Applicants gratefully acknowledge the indication of allowable subject matter in claims 7, 16, 19, 21-23, 38 and 39.

Applicants note that claims 7, 16, 38 and 39 are independent claims. These claims were put into independent form in the previous Amendment (filed October 15, 2004), incorporating all of the limitations of previously dependent claims. This was in response to an indication of allowable subject matter in the previous Office Action (mailed July 15, 2004). Applicants respectfully submit that the present Office Action should have indicated these claims as being "allowed," rather than "allowable if put in independent form."

Claim 20 has been rewritten to incorporate all of the limitations of allowable claim 21, and claim 21 has been cancelled. Thus, Claim 20 should be allowable as set forth in the Office Action at page 4.

Claims 8, 10-15, 17 and 19 are now dependent on allowable Claim 7, directed to an ink composition, and should also be allowable for the same reasons as Claim 7. Claims 22-23, 25, and 28-30 are dependent on allowable method Claim 20, and should also be allowable for the same reasons as Claim 20.

Applicants note that original claim 2 was indicated as being allowable in the Office Action dated July 15, 2004. In the Amendment filed October 15, 2004, dependent Claim 2 was rewritten as independent Claim 37, incorporating all of the limitations of the base claim, together with the limitation that an image formed on an edible substrate has a resolution of greater than 300 dpi. In the Office Action, Claim 37 has been grouped with the claims rejected under 35 U.S.C. § 102(e), but no specific mention is made of this claim or of the 300 dpi resolution limitation. As amended, Claim 37 does not use the word "about." Thus the image resolution claimed is much higher than shown in the reference, and applicants respectfully request reconsideration for the reasons set forth below.

Applicants note that claims 24 and 27 are listed as being rejected in the Office Action summary. These claims were cancelled by the Amendment filed October 15, 2004. Claims 24 and 27, which were indicated as being allowable in the Office action dated July 15, 2004, were rewritten as independent claims 40 and 41, which are now indicated as being rejected under Section 103, although no specific mention is

made of these claims, or of the 300 dpi claim limitation. Applicants respectfully request reconsideration for the reasons set forth below.

In view of the foregoing, the remaining issues relate to: (1) Claims 3-5, 35, and 37, which are product-by-process claims directed to the edible end product; and (2) Claims 36 and 40-41, which are directed to methods of ink-jet printing on edibles.

III. Rejections Over Prior Art

Claims 1, 3-4, 6, 10-15, 17, 18, 31-35 and 37 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2003/0101902 A1 to Reitnauer et al., and Claims 5, 8, 20, 25, 28-30, 36, 40 and 41 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Reitnauer in view of WO 01/94116 A2 (Willcocks et al.), which is commonly assigned with the present application. Insofar as these rejections apply to the amended claims, applicants respectfully traverse.

Product by process Claims 3-5 depend from Claim 33, and therefore, each of them requires that an image is formed having a resolution greater than 150 dpi. To reduce the issues for consideration, the amended claims require a resolution greater than 150 dpi, rather than “greater than about 150 dpi.” Likewise, Claim 35 is now a product by process claim dependent on Claim 36, which also recites an image resolution of greater than 150 dpi (which was not amended). As the applicants have noted previously, the highest resolution achievable with the Markem printer disclosed in Reitnauer is 96 dpi (See Reitnauer para. [0033]). The maximum dpi achievable with the Markem printer is given as a precise number, related to the number of nozzles. In this context, one of ordinary skill in the art would recognize that the claimed resolution of “about 150 dpi”

does not encompass 96 dpi, as this would require a different printer (as consistently argued throughout the present specification). To achieve an image with the claimed resolution requires a high resolution printer. In any event, applicants submit that claims 3-5 and 35 are not anticipated by Reitnauer, at least because the prior art does not disclose a method utilizing a printer which can deliver sufficient resolution, or an edible product having an image on it with the claimed resolution. These arguments apply with even greater force to claims 37 and 40, which recite an image resolution of “300 dpi.”

With respect to the rejection under Section 103, to support a rejection of the present claims over the cited art, it is necessary to show that one of ordinary skill in the art would be motivated to use a high resolution printer with the claimed ink, with the reasonable expectation that edibles having such a high resolution image could be produced. This motivation and expectation are not disclosed in either Reitnauer or Willcocks, and applicants submit that the claims that require a high resolution image are allowable over the art of record.

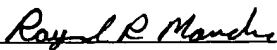
Claim 41 recites a non-obvious method of printing on a hydrophobic surface of a lentil shaped confectionery (such as M&M’S® Milk Chocolate Candies). This was previously indicated as being allowable subject matter. It would not have been obvious that a high resolution image could be ink-jet printed on this substrate, because the surface is resistant to the inks that are commonly used in an ink-jet printer, and the non-planar surface makes it difficult to achieve a high resolution image. Applicants submit that Reitnauer and Willcocks do not teach or suggest that the claimed substrate could be reliably printed on with a high resolution ink-jet system utilizing the claimed

wax based ink. For these reasons, and all of the foregoing reasons, applicants submit that all of the claims are allowable over the prior art of record.

In view of the foregoing amendments and remarks, favorable reconsideration and the early passage to issue of this application are respectfully requested.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Raymond R. Mandra
Attorney for Applicants
Registration No. 34,382

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

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